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In re application of :
Scherzer et al. : DECISION ON
Serial No. 10/784,815 : PETITION
Filed: February 24, 2004 :
For: OPEN-CELL FOAM COMPOSED OF HIGH-MELTING POINT PLASTICS

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 17, 2006.

On February 2, 2006, a non-final office action was mailed to applicants rejecting various claims, including claims 1, 3 and 4 over the cited Hoki reference. A reply to the office action was filed by Applicant on May 5, 2006. In the reply, Applicant made several amendments to the claims. One of these amendments was to incorporate limitations from original claims 3 and 4 into independent claim 1. On July 17, 2006, a final office action was mailed.

On October 17, 2006, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the July 17, 2006 office action.

Applicants position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

**DECISION**

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

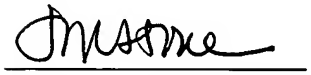
Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because amended claim 1 was merely incorporates limitations from original claims 3 and 4, which were rejected by the Hoki reference, the new grounds of rejection applied by the examiner to this claim and then made final were improper. This argument is persuasive. Claims 1, 3 and 4 were originally rejected over Hoki, as being anticipated, in the office action of February 2, 2006. Amended Claim 1 was then rejected over the newly cited reference to Mitsubishi in the final office action mailed July 17, 2006, and the Hoki reference was dropped. The limitations of amended claim 1, incorporating limitations of original claims 3 and 4, which according to the examiner in the non-final office action of February 2, 2006, where anticipated by the Hoki reference. If the Hoki

reference was appropriately applied to original claims 1, 3 and 4, then it should also have been appropriate to apply to amended claim 1, as amended by the reply of May 5, 2006. Since, the Hoki rejection was dropped in favor of Mitsubishi in the final office action of July 17, 2006, the amendment did not require the new grounds of rejection in the final office action.

Since the rejection of claim 1 over Mitsubishi was not necessitated by amendment, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED.**

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. It is also noted that Applicants filed a timely amendment on October 17, 2006. This amendment will be treated as an amendment after a non-final office action and will be entered. The application is being forwarded to the Examiner for consideration of said amendment and appropriate action thereon.



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